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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,411	10/12/2001	Amy B. Reed	NPI-30 (14845)	1102

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/976,411	Applicant(s) REED ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

1. The art rejections are maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 42-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (US 5,191,734) in view of E.W. Flick, "Water-Soluble Resins - An industrial Guide (2nd edition)", 1991, pages 163-181. Weber teaches a biodegradable latex web material as a surgical gown comprising a fibrous web being saturated with a latex binder having a glass transition temperature from -50°C to 20°C (abstract). The latex composition is a natural, synthetic or a combination of natural and synthetic polymers as shown in table II. The latex composition comprises a polyacrylate, nitrile rubber, natural rubber or a combination thereof (column 4, lines 31-34, and table II). The latex binder is about 16 to 80 dry parts per 100 parts fibers by weight (column 5, line 29) within the claimed range. Although the glass transition temperature (T_g) of Hycar ®1570X55 is not expressly recited in Weber '734 (table II), US Patent no. 5,370,132 to Weber et al indicates that Hycar ® 1570X55 has a T_g of -48 °C (see table IV of Weber '132). Similarly, Weber '132 evidences that natural rubber Hartex ® 104 having a T_g of -70°C. The latexes of Hycar ®1570X55 and rubber Hartex ® 104 read on Applicants' additional polymer emulsions. Likewise, in

accordance with the reference disclosure, it is acceptable and possible to use the latexes having a T_g less than -50°C . Weber does not specifically disclose the use of a polyacrylate latex having a T_g of -20°C or lower. Flick, however, discloses the hystretch elastomeric latexes as the paper saturants to add durability and resiliency to the paper web (page 181). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use hystretch elastomeric latex as a paper saturant of the Weber product motivated by the desire to add durability and resiliency to the paper web. The examiner notes that Flick also discloses the HYCAR acrylic latex 26146 as a paper saturant having a T_g of -55°C (page 174). Flick teaches the HYCAR acrylic latexes stable in processing, compounded easily and containing no solvents to cause flammability or toxicity hazards during processing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the HYCAR acrylic latex 26146 as a paper saturant of the Weber product motivated by the desire to obtain an ease of the processing. Weber does not specifically disclose the biodegradable latex web material having a Gurley Hill porosity and exhibiting a % BFE as recited in the claims. However, it appears that the biodegradable latex web material of Weber as modified by the Flick is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder has a glass transition temperature within the claimed range. Hence, it is the examiner's

position that the Gurley Hill porosity and the percent bacterial filtration efficiency (BFE) would be inherently present. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

Response to Arguments

4. The art rejections have been maintained for the following reasons. Applicants argue that the preamble "medical packaging material" acts as a limitation when read in the context of the disclosed invention, the present claims patentably define over Weber. The examiner respectfully disagrees. The preamble "medical packaging substrate" is not considered a limitation and is of no significance to claim construction because (i) the body of claim described a latex saturated paper without the preamble, and (ii) the specification referring "bacterial filtration efficiency" property did not constitute "clear reliance" on the preamble needed to make the preamble a limitation.

Applicants argue that Weber does not disclose the claimed % BFE because a variety of parameters may be altered to influence % BFE. The arguments are not found persuasive for patentability because none of specific parameters that may materially change the claimed % BFE have been included in the claims. The arguments are not commensurate in scope with the claims. The examiner continues to maintain that % BFE is inherently present as the claimed medical packaging substrate is not differentiated from prior art biodegradable latex web satisfying the claimed structural limitations.

Applicants argue that Weber discloses the polyacrylate latexes having a T_g of between -15°C or greater, one of ordinary skill in the art would not be motivated to use a polyacrylate latex having a T_g of less than -15°C to achieve the claimed invention. The examiner respectfully disagrees. Weber discloses the use of latexes having a T_g of between -50°C and 20°C . There are no particular restrictions on the polyacrylate latex having a T_g in a specific range for any desired properties or any particular applications. Therefore, in the context of the full disclosure of Weber, any polyacrylate latexes having a T_g of between -50°C and 20°C are suitable for the biodegradable latex web.

Applicants assert that it is improper to use the Applicants' specification to provide the suggestion for modifying the prior art. The arguments appear to be flawed and incomplete. The examiner directs Applicants' attention to the article "Water-Soluble Resins - An industrial Guide (2nd edition)", 1991, pages 163-181. The article discloses the hystretch elastomeric latexes as the paper saturants to add durability and resiliency to the paper web (page 181). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use hystretch elastomeric latex as a paper saturant of the Weber product motivated by the desire to add durability and resiliency to the paper web. The examiner notes that the article also discloses the HYCAR acrylic latex 26146 as a paper saturant having a T_g of -55°C (page 174). Flick teaches the HYCAR acrylic latexes stable in processing, compounded easily and containing no solvents to cause flammability or toxicity hazards during processing (page 174).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the HYCAR acrylic latex 26146 as a paper saturant of the Weber product motivated by the desire to obtain an ease of the processing. Accordingly, the art rejections are sustained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vo

**HAI VO
PRIMARY EXAMINER**

HV